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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,505	01/02/2000	MICHAEL HERMAN KOCH	54270/	7382

7590

02/20/2003

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EXAMINER

TALBOT, BRIAN K

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 02/20/2003

28

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/403,505

Applicant(s)

KOCH ET AL.

Examiner

Brian K Talbot

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1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-15, 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-11, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/15/03 has been entered.

2. Claims 2-15, 17 and 18 remain in the application with claims 12-15 being directed toward a non-elected invention. Applicant is encouraged to cancel non-elected claims so as to place application in condition for subsequent actions.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

4. Claims 2-7 and 18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for coating an optical fiber, does not reasonably provide enablement for "all non-planar substrates". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

***Claim Rejections - 35 USC § 103***

5. Claims 1-11 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winn et al. (5,168,540) in combination with Donckel et al. (3,860,444) or further in combination with either Wernberg et al. (5,258,204) or Biswas et al. (4,790,625).

Winn et al. (5,168,540) teaches coating a fiber by CVD with a scintillating material. The scintillating material can be a number of metal compounds including zinc oxide (abstract). Looking at Figure 2, a source gas of the scintillating material (208) is supplied into a deposition chamber (202) where a substrate (212) is located on a holder (210). The substrate can be an optical fiber (col. 2, lines 65-69). The holder (210) can be heated so as to aid in the deposition of the coating material (col. 7, lines 5-30). In example II, a heated manifold is utilized to heat the substrate.

Winn et al. (5,168,540) fails to teach heating the source material to provide the gaseous coating material.

Donckel et al. (3,860,444) teaches coating a fiber by CVD wherein the coating material is heated to form a vapor that is subsequently coated on the fiber.

Therefore, it would have been obvious at the time the invention was made to have modified Winn et al. (5,168,540) CVD process by incorporating a "heated source" material as opposed to a source material which is already in gaseous form because of the expectation of achieving similar results.

With respect to claim 9-11, the claims recite "clamping" the fiber substrate. While the Examiner acknowledges the fact that Winn et al. (5,168,540) teaches gluing the fiber substrate to

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the holder, it is the Examiner position that one skilled in the art at the time the invention was made would have had a reasonable expectation of achieving similar results regardless of the holding mechanism utilized. Furthermore, the use of "clamps" to hold a substrate such as a fiber for coating is convention in the coating art.

Winn et al. (5,168,540) in combination with Donckel et al. (3,860,444) fail to explicitly teach heating the substrate to the decomposition temperature of the coating material.

Wernberg et al. (5,258,204) or Biswas et al. (4,790,625) both teach preheating a substrate to the decomposition temperature of a coating gas contacted thereon.

Therefore, it would have been obvious for one skilled in the art at the time the invention was made to have modified Winn et al. (5,168,540) in combination with Donckel et al. (3,860,444) by preheating the substrate to the decomposition temperature of the coating material as evidenced by Wernberg et al. (5,258,204) or Biswas et al. (4,790,625) because of the expectation of achieving similar success.

### ***Response to Amendment***

6. Applicant's arguments filed 1/15/03 have been fully considered but they are not persuasive.

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Applicant argued that the 35 USC 112 first paragraph rejection is improper.

The Examiner disagrees. The claim language "external circumference surface" can encompass a shape such as a ball or oval which is not enabled by the specification.

Applicant argued that the combination of art fail to teach that the fiber is heated to the decomposition temperature of the fiber.

The Examiner agrees in part. While the references, Winn et al. (5,168,540) and Donckel et al. (3,860,444) fail to explicitly teach this limitation, it is the Examiner's position that this is implicitly implied. First off, if the temperature is not at least at the decomposition temperature the films would not be "grown" as detailed. Furthermore, the Examiner has supplied two secondary references which teach this concept of having the substrate temperature at the temperature to "form" the coating.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K Talbot whose telephone number is (703) 305-3775. The examiner can normally be reached on Tuesday-Friday 7AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-6078 for regular communications and (703) 305-6357 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3775.

A handwritten signature in black ink, appearing to read "B-K Talbot", with a long horizontal flourish extending to the right.

Brian K Talbot  
Primary Examiner  
Art Unit 1762

BKT  
February 14, 2003